

APPENDIX C
Extract from Landis on Mechanics of Patent Claim Drafting
4th Edition
§ 16A

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Landis on Mechanics of Patent Claim Drafting

Fourth Edition

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§ 16A

Mechanics of Patent Claim Drafting

2. What are its constituent parts, if any, or distinctive features, that is, what features are necessary for the purposes of this claim to distinguish this element from any other element of the class?
3. How are it and its parts cooperatively associated with at least one other of the other elements or parts to accomplish the desired result? Or, what is the necessary connection and cooperation between the elements and parts?
4. Where pertinent, what does each element do and how does it do it?
5. Under (3) and (4), each element must be related structurally and/or in terms of functional cooperation or both with at least one other element.

One analogy is to think of the elements as islands, the parts of elements as peninsulas, and the statements of connection and cooperation as bridges. When the claim is done, all islands must be connected by bridges. Thus one composes a claim to a complete mechanical combination, or "machine."

Summary

Find the main elements or parts of the machine to be claimed. Make each element the subject of one clause of the body of the claim. The claim must name the elements and tell how they are related to each other either physically and/or functionally and cooperatively to be the article or to do the job stated in the preamble.

The following sections focus on how to do all this.

§ 16A Workpiece or Environmental Element

Most claimed apparatus operate upon something or use something, or are operated upon and/or used by something else. Similarly, most methods act on something or involve something that is acted upon. That workpiece or environmental element should be recited for a claim to be complete and make sense. Yet, it should not be claimed in a manner suggesting that it is one of the elements of the invention claimed.

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Where the workpiece or environmental element is important in the claimed structure, it might appear in the preamble of the claim, as for example, "A juicer for squeezing citrus fruit, the juicer comprising . . ." or "A grinder for grinding rolls . . .", or perhaps have the workpiece as a modifier of the claimed apparatus as "A roll grinder comprising . . ."

Not every workpiece or environmental element used with a claimed apparatus or method is a major element or is desirably included in the preamble. The preamble "A juicer comprising . . ." does not require mention of the citrus fruit. The preamble "A telescope comprising . . ." does not require mention of the objects observable to be recited in the claim preamble.

But, no matter whether it is recited in the preamble, a workpiece or environmental element typically is recited in the body of the claim with reference to the element of the claim that the workpiece cooperates with or acts upon or which acts upon the workpiece.

In contrast to an element of the claim, the workpiece or environmental element is introduced in the claim by words indicating that the workpiece is not one of the claim elements. Therefore, it is not written as the subject of a clause of the claim. Rather, the workpiece or environmental element is introduced inferentially in the claim, which is contrary to what is done with a claim element. An element is inferentially introduced in a claim if it first appears within the body of a claim clause as itself acting or being acted upon, without first having been introduced either as the subject of that clause or a preceding clause and without another element recited as having or being that workpiece or environmental element. (By "having or being," I mean reciting "the element comprising (being) (including) the workpiece"). For example, in an apparatus claim, the workpiece might be introduced in a clause: "the juicer including a crusher (an element of the claimed apparatus being introduced in this clause) for acting on a piece of citrus fruit (the workpiece) . . ." or "a grinding wheel acting on a roll (the workpiece is mentioned for the first time) supported in the vicinity of the wheel for grinding the surface (workpiece) of the roll (second mention of the workpiece) . . ." In these examples, the workpiece is first mentioned in the middle of a clause having another

element as its main subject and the workpiece is introduced or for the first time mentioned using the indefinite article "a," whereby it is being inferentially claimed. Each succeeding mention of the same workpiece can be preceded by the definite article "the," but preferably not with the definite article "said" because that word has typically been used for referring back to a previous actual claim element.

Conventional and environmental elements present, but not critical to the invention being claimed should not be mentioned as claim elements. For claiming an automobile, one would not claim environmental material that is present in the engine, such as fuel, as a claim element. For a telescope, one would not recite the celestial object being viewed as one of the claim elements, although its cooperation with the lenses and the image collector certainly is important.

Conventional replaceable items that would not normally be made or sold by the party who is making the claimed invention should also preferably not appear in the claim, except perhaps by inference, as an environmental element, so as not to restrict the scope of the claim. Examples of this are discussed in section 35 below. An electrical system might include a power supply or an antenna. An automobile includes tires, or a battery. Respective supplies are used for a particular apparatus, such as fuel used to drive an engine, gas used to fill a balloon, thread in a sewing machine, etc. These should not be claim elements at all, or if they appear, they should be claimed inferentially as workpiece or environmental elements.

One would always rather catch a direct infringer under 35 U.S.C. section 271(a) than a contributory one under 35 U.S.C. section 271(c). To catch the manufacturer for infringement, you do not recite the element he would not include. If you write those elements into the claims, the manufacturer becomes only a contributory infringer, and only his customer, the retailer or the ultimate consumer, becomes the actual infringer.

Summary

Inferentially claim workpieces and environmental elements and inferentially claim elements not critical to the claimed combination which are not likely to be made and/or sold by the patentee. Do not recite them as one of the claim elements. This broadens the claim scope by not including elements not supplied by the patentee.

§ 17 Negative Limitations

In the past, negative limitations, telling what an element is not instead of what it is, were generally considered improper except in unusual cases. However, MPEP 2173.05(i) states:

"The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation."

There normally would be no problem that a negative limitation per se would make a claim too broad, indefinite, etc.

Under this practice, such descriptions as "halogen other than fluorine" would presumably be acceptable. Such expressions as "noncircular," "nonmagnetic" or "colorless" have always been accepted because there is no other practical way to state the concept. In view of the former antipathy, it is suggested the negative statements still be avoided except where it seems the only way, or by far the clearest way, to state the limitation. MPEP 2173.05(i) provides as acceptable examples: "not in excess of 10% structure" and "incapable of forming a dye with. . ."

In *In re Duva*,⁴ a negative limitation, "absent sufficient CN [cyanide] ions to prevent deposition . . .," was held proper even if a positive expression could have been employed, which was disputed. Further, it was held proper to claim a negative limitation even at the "point of novelty," but there were other points of novelty.

Perhaps negative limitations, under the *Duva* case and MPEP 706.03(d), could be used in some cases to avoid the limiting language "consisting" or "consisting essentially" (section 8). For example, if one's claim covered the combination comprising A+B+C,

4. 156 U.S.P.Q. (BNA) 90, 94 (C.C.P.A. 1967).